

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOSEPH C. KAWAN, MELVIN TAKATA and COLEMAN HANOVER



Appeal No. 2004-0258
Application No. 09/313,297

ON BRIEF

Before HAIRSTON, NASE, and DIXON, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 69,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to electronic scrip transactions and more particularly to a system and method for performing and settling transactions using an automated electronic scrip (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rosen	5,453,601	Sept. 26, 1995
Masi et al. (Masi)	6,105,001	Aug. 15, 2000

Claims 1 to 69 stand rejected under 35 U.S.C. § 103 as being unpatentable over Masi in view of Rosen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 18, mailed July 30, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 17, filed June 16, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 69 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection under 35 U.S.C. § 103 before us in this appeal, the examiner ascertained that Masi lacked electronic scrip, a scrip distributor account, and a scrip clearing center as recited in the independent claims under appeal (i.e., claims 1, 52 and

69). The examiner concluded that the claimed electronic scrip, scrip distributor account, and scrip clearing center would have been obvious from Rosen's disclosure of electronic money. We do not agree for the reasons set forth by the appellants on pages 6-11 of the brief.

In our view, the examiner's determination (answer, p. 7) that Rosen's electronic money is "equivalent to" the appellants electronic scrip is without merit. We believe that the broadest reasonable meaning of electronic scrip in its ordinary usage as it would be understood by one of ordinary skill in the art, taking into account the enlightenment afforded by the written description contained in the appellants' specification¹ is that electronic scrip is a type of electronic currency which has a merchant identified at the time of issuance of the cash and such that the electronic currency can only be spent with that merchant.²

Using that definition of electronic scrip it is clear the neither Masi not Rosen teach or suggest electronic scrip, a scrip distributor account, or a scrip clearing center as recited in the independent claims under appeal. Thus, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of

¹ See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

² See column 5, lines 35-38, of U.S. Patent No. 6,029,150 to Kravitz.


obviousness with respect to the claims under appeal. Accordingly, the decision of the examiner to reject claims 1 to 69 under 35 U.S.C. § 103 is reversed.


CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 69 under 35 U.S.C. § 103 is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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